

### **REMARKS**

Claims 149-313 are pending in this application. Claims 149-203 and 205-313 stand rejected in the Office Action dated October 29, 2004 ("Office Action"). Applicants appreciate the Office's recognition of allowable subject matter in claim 204; however, Applicants provide the above amendments to the specification and the below remarks to further the prosecution of all claims in this application toward allowance.

#### **Claim to Priority**

The Office notes that a reference to prior U.S. Application Serial No. 09/018,563 must be included in either the specification or an Application Data Sheet in order for this application to receive the benefit of priority under 35 U.S.C. § 120. See Office Action at page 2. Applicants note that the substitute specification, filed on March 17, 2004, in accordance with 37 C.F.R. § 1.125, recites the priority information for this application in paragraph [01] on page 2. Thus, Applicants believe that the priority information for this application has been properly presented and that priority has been properly claimed. To further demonstrate the claim of priority, Applicants have submitted an Initial Application Data Sheet with the priority information shown in the appropriate section. Applicants would appreciate the Office's written statement recognizing the priority of this application in the next Office Action or Notice of Allowance.

Applicants have herein amended paragraph [01] of the substitute specification to provide an update for parent Application Serial No. 09/018,563, as it has issued as U.S. Patent No. 6,740,373 since the filing of this application. As this amendment adds no new matter to this application, Applicants respectfully request that it be entered.

## **Objection to Title**

The Office objected to the title of this application as too long. Merely to comply with the Office's suggestion, and without acceding to the propriety of the objection or impacting the scope of the presently-claimed invention, Applicants have herein amended the title to the suggested length of five words, reading "Texture-Coated Insulating Paperboard Containers." Applicants note that the concurrently submitted Application Data Sheet reflects this amended title. As this amendment adds no new matter, Applicants respectfully request that it be entered and the objection withdrawn.

## **Obviousness-Type Double Patenting Rejection**

The Office has rejected claims 149-203 and 205-313 under the judicially-created doctrine of obviousness-type double patenting over U.S. Patent No. 6,379,497 to Sandstrom et al. ("the '497 patent"). Merely to obviate this rejection, and without commenting on its propriety, Applicants have submitted a Terminal Disclaimer over the '497 patent in compliance with 37 C.F.R. § 1.321(c). Upon approval of this Terminal Disclaimer, Applicants respectfully request that this rejection be withdrawn.

Applicants call to the Office's attention that the '497 patent is now the subject of co-pending Reissue Application Serial No. 10/662,035. This reissue application is listed on the concurrently submitted Information Disclosure Statement. According to PAIR, this reissue application has not yet begun prosecution. See Appendix A. Applicants note that the Terminal Disclaimer does not disclaim the terminal part of any patent granted on the instant application that would extend beyond the expiration date of the '497 patent in the event that patent is reissued. See Terminal Disclaimer, page 2,

paragraph 2. This provision is expressly allowed by MPEP § 1490 (see Eighth Edition, Revision 2, May 2004, at page 1400-94) and the PTO's own sample Terminal Disclaimer form PTO/SB/26. As such, Applicants submit that the reissue application of the '497 patent should not preclude the effectiveness of the submitted Terminal Disclaimer to obviate the instant obviousness-type double patenting rejection.

### Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and the continued examination of this application and the timely allowance of the pending claims. Should the Office continue to assert that all of the claims are not in condition for allowance, Applicants respectfully request that the Office contact their representative at the telephone number listed below.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

*Robert Stanley*  
*Reg. No. 55,830*

Dated: January 31, 2005

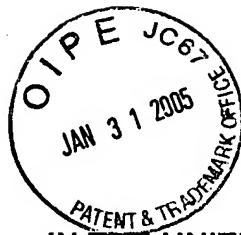
By: \_\_\_\_\_

*for*

Lori-Ann Johnson  
Reg. No. 34,498

Telephone: 404-653-6460

**Attachments: Appendix A—PAIR Printout for Reissue App. Ser. No. 10/662,035**



REPLY TO OFFICE ACTION  
Application Serial No. 10/801,825  
Attorney Docket No. 02734.0411-02000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Dean P. SWOBODA et al.	)	Group Art Unit: 1772
	)	
Application No.: 10/801,825	)	Examiner: Sandra M. RAYFORD
	)	
Filed: March 17, 2004	)	
	)	
For: TEXTURE-COATED INSULATING	)	Confirmation No.: 2991
PAPERBOARD CONTAINERS	)	
(as amended)	)	

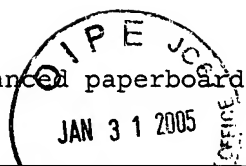
**APPENDIX A**

PAIR Printout for Reissue Application Serial No. 10/662,035

Printer Friendly

10/662,035 Bulk enhanced paperboard and shaped products made therefrom

Application Data



Application Number:	10/662,035	Customer Number:	-
Filing or 371 (c) Date:	09-15-2003	Status:	Application Dispatched from Preexam, Not Yet Docketed
Application Type:	Re-Issue	Status Date:	02-11-2004
Examiner Name:	-	Location:	ELECTRONIC
Group Art Unit:	-	Location Date:	-
Confirmation Number:	2041	Earliest Publication No:	-
Attorney Docket Number:	02734.0560-00000	Earliest Publication Date:	-
Class / Subclass:	-	Patent Number:	-
First Named Inventor:	Erland Sandstrom , Sister Bay, WI (US)	Issue Date of Patent:	-
Title of Invention:	Bulk enhanced paperboard and shaped products made therefrom		

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